

Appl. No. 10/054,628
Atty. Docket No. 7571RD
Reply Dated Feb. 14, 2005
Reply to Office Action of Dec. 14, 2004

REMARKS

Claims 1-4 are pending in the present application and stand rejected. Applicant respectfully request consideration of the following remarks and withdrawal of the rejection.

COMMENTS REGARDING FINAL REJECTION

The Office states that, "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, this action is made final. See MPEP § 706.07(a)." Applicant asserts that the finality of the Office Action is in error. MPEP § 706.07(a) states that "[a] second or any subsequent action on the merits in any application . . . should not be made final if it includes a rejection, on prior art of record, of any claim amended to include limitation which should have been expected to be claimed." In response to the first Office Action, Applicant amended Claim 1 to delete one member from a Markush group. The Office, in the current Office Action, bases the rejection on a patent not previously of record. Applicant asserts that Claim 1 was "amended to include [a] limitation which should have been expected to be claimed." Namely, all the members of the Markush group as currently presented were previously presented. As a result, the finality of the present Office Action is erroneous.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Applicants respectfully submit that the Office has failed to make a *prima facie* case for the obviousness rejections presented below. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. See *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); MPEP § 2143.01. Second, there must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP § 2143.02. Third, the prior art reference or combined references must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981 (CCPA 1974); MPEP § 2143.03. Furthermore, the Court of Appeals for the Federal Circuit has stated that "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443 (Fed. Cir. 1992).

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,609,587 to Roe (hereafter "Roe") in view of U.S. Patent No. 5,416,158 to Santhanam et al. (hereafter "Santhanam"). With regard to Claim 1, the Office states:

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Roe discloses the present invention substantially as claimed. However, Roe does not disclose the exact amount of a rheological agent present in the lotion composition. Roe teaches the lotion composition can have optional components, such as a stabilizer. Roe Recognizes the amount of components can be varied and this will affect the viscosity of the lotion composition. Roe, therefore recognizes the stability of the composition is a result effective variable of percentage of components used, including the percentage of the rheological agent. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Roe with the claimed amount of rheological agent, since discovering an optimum value of a results effective variable involves only routine skill in the art.

Applicant traverses the Office's rejection

Roe discloses a lotion composition that can comprise other optional components. Roe discloses, "stabilizers or antioxidants can be added to enhance the shelf life of the lotion composition such as cellulose derivatives, proteins and lecithin." However, the Office fails to cite a reference to a "rheological agent" within Roe. The Office has not provided any argument that "stabilizers or antioxidants" necessarily teach or are equivalent to rheological agents.

The Office further states, "Roe does not specifically disclose the use of the claimed rheological agents. Santhanam discloses the claimed rheological agents in personal care products to impart a smooth feel and texture to the products. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the skin care composition of Roe to include one of the claimed rheological agents for the benefits taught in Santhanam." Applicant traverses this rejection. Santhanam discloses in its Background section a variety of materials that are capable of providing rheological properties including thickening to aqueous compositions. Col. 1, lines 20-59. However, the Office still has not made a *prima facie* case of obviousness.

First, the Office has made no attempt to apply the Graham factors as enunciated in *Graham v. John Deere*, 383 U.S. 1 (1966). There appears to be no determination of the differences between the prior art and the claims in issue. There appear to be no resolution as to the level of ordinary skill in the pertinent art. Since the Office has not applied the Graham factors, a *prima facie* case of obviousness has not been established.

Second, the Office has failed to distinctly state the motivation for combining Roe and Santhanam; furthermore, Santhanam appears to teach away from the modification proposed by the Office. The Office, in support of the proposed combination, states that "[i]t would have been obvious to one having ordinary skill in the art at the time of the invention to modify the skin care composition of Roe to include one of the claimed rheological agents for the benefits taught in Santhanam." Applicant is uncertain as to the benefit to which the Office suggests. In the relevant section of the background to which the Office cites, the materials are disclosed as being "capable of providing rheological properties including

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thickening of aqueous compositions." Conversely, the present application states, "The skin care compositions of the present invention are substantially anhydrous." See page 10, line 1. Applicant asserts that one skilled in the art would not take the teachings of Santhanam directed to thickeners of aqueous compositions and apply them to the anhydrous compositions of the present invention. In fact, these teachings would be deemed as teaching away from the present invention. One skilled in the art would not have referenced Santhanam since it is clearly directed to aqueous thickeners rather than anhydrous thickeners.

Since Claim 1 is nonobvious in light of the arguments presented above, Claims 2-4, dependent from and containing all the limitations of Claim 1, are likewise nonobvious.

CONCLUSION

Based on the foregoing amendment and reasons, Applicants respectfully submit that the Office has not made a *prima facie* case of obviousness and the rejections are therefore improper. Reconsideration and withdrawal of the rejections are respectfully requested. Allowance of each of the pending claims is earnestly requested so that the Request for Interference as submitted on January 22, 2002 may be granted.

Respectfully Submitted,

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